

### **REMARKS/ARGUMENTS**

The present paper is in response to the Advisory Action mailed October 14, 2004, and is in further response to the final Office Action mailed June 15, 2004, in which Claims 1 through 10, 12 and 14 through 18 were rejected. Applicants have thoroughly reviewed the outstanding Advisory Action and the outstanding Office Action including the Examiner's remarks and references cited therein. The following remarks and the accompanying Declaration are believed to be fully responsive to the Advisory Action and to the Office Action and are believed to render all claims at issue patentably distinguishable over the cited references.

No claim is amended herein. No claim is cancelled herein. No claim is added herein. Accordingly, Claims 1 through 10, 12 and 14 through 18 remain pending.

Applicants respectfully request reconsideration in light of the following remarks.

### **CLAIM REJECTIONS – 35 U.S.C. SECTION 103(a)**

In the Office Action of June 15, 2004, the Examiner rejected Claims 1 through 10, 12, and 14 through 18 under 35 U.S.C. Section 103(a) as being unpatentable over:

- EP 148600 or Thomas *et al.* in view of Satoh *et al.* and further in view of Chigurapati *et al.* or Olsen;

- Chiguarapati *et al.* or Olsen taken with Satoh *et al.*;
- Dalbøge *et al.*, Edens *et al.*, or Schoenmaker *et al.* in view of Satoh *et al.*

#### **APPLICANTS' RESPONSE OF AUGUST 16, 2004.**

In their Response of August 16, 2004, Applicants initially reviewed the invention then analyzed each of the cited references in turn. Applicants then respectfully argued that there was no motivation to make the combination proposed by the Examiner.

Thereafter Applicants argued that even if there was motivation to combine the cited references the resulting combinations would still fail to render obvious the invention as claimed. In support of this argument, Applicants respectfully submitted examples of how the combinations proposed by the Examiner would fail to render the present invention obvious.

Applicants finally requested that the Examiner's rejections under 35 U.S.C. Section 103(a) be reconsidered and withdrawn.

#### **THE EXAMINER'S ADVISORY ACTION OF OCTOBER 14, 2004**

In his Advisory Action of October 14, 2004, the Examiner maintained his rejection of Claims 1 through 10, 12 and 14 through 18 for the reasons of record. In addition, the Examiner acknowledged Applicants' arguments but stated that Applicants have shown no unexpected results for the process and only speculate why they think the references would not perform the claimed process. The

Examiner further stated that without any evidence, Applicants cannot assume that the references would not result in the claimed process.

### **PRESENT RESPONSE**

Applicants again respectfully traverse the Examiner's rejections and, as a general matter, submit that the proposed combinations, even if appropriate, do not teach, suggest, or otherwise render obvious the invention as presently claimed.

In support of their argument that the Examiner's proposed combinations would fail to result in the claimed process, Applicants submit herewith a Declaration executed by Mr. Appu Rao Gopala Rao Appu Rao, the first-named inventor of the present invention. In this paper, the Declarant references experiments that demonstrate the undesirability of making the combinations proposed by the Examiner. As set forth therein, the inventors/applicants experimented with all of the five options described therein to identify the most suitable one for obtaining protein hydrolysate. Applicants claim only this most suitable approach and note that the protein hydrolysate obtained should have certain characteristics, as specified in Claim 1 of the present invention. In fact, and as set forth in the accompanying Declaration, it is not possible to obtain a product having the necessary and claimed characteristics using any other process.

Applicants also respectfully submit that the Examiner has failed to cite any document which teaches that out of the five possible combinations, the best results would be obtained if Option 5 was chosen.

Applicants further respectfully submit that the Examiner has arrived at the conclusion that a person skilled in the art would adopt the process described in Option 5 with the benefit of hindsight. The present invention as shown in the cited documents does not show any reasonable expectation of success. In the absence of reasonable expectation of success, it cannot be inferred that the combination of the documents destroy the inventiveness of the present invention.

Applicants respectfully conclude by noting that these arguments are presented in addition to the arguments already provided that it is not technically possible for a person skilled in the art to combine the documents cited by the Examiner in such a way as to produce the claimed invention.

### **CONCLUSION**

In light of the above amendments and remarks, Applicants respectfully submit that all pending Claims 1 through 10, 12 and 14 through 18 as currently presented are in condition for allowance. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 248-433-7552 in an effort to resolve any matter still outstanding *before* issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out by telephone.

Applicants respectfully request that a timely Notice of Allowance be issued  
in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas T. Moga', with a long horizontal flourish extending to the right.

Thomas T. Moga  
Registration No. 34,881  
Attorney for Applicants

BUTZEL LONG  
100 Bloomfield Hills Parkway, Suite 200  
Bloomfield Hills MI 48304  
248-258-4496

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TTM/hs